

REMARKS / DISCUSSION OF ISSUES

Claims 1-16 and 18 are pending in the application.

The Examiner rejects claims 1-2, 4-16, and 18 under 35 U.S.C. 102(e) over Inoue et al. (USPA 2003/0028622, hereinafter Inoue). The applicants respectfully traverse this rejection.

MPEP 2131 states:

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)... "The **identical invention** must be shown in as **complete detail** as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Also, the Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a *prima facie* case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements is found in the prior art:

"**there must be no difference** between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a *prima facie* case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where **all** of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

The applicants teach a technique that overcomes one or more problems associated with digitally signing usage rights to content material. The applicants detail the advantages provided by digital signing over other forms of protection, identifies deficiencies in the conventional techniques for digitally signing usage rights, and presents novel techniques that are well suited to cure these deficiencies. Specifically, the applicants teach and claim decomposing the usage right into a set of partial rights, and subsequently separately signing each one of the set of partial rights.

The Office action does not address the digital signing of each of a set of partial rights, and does not identify the particular parts of Inoue that are asserted to correspond to the applicants' claimed digital signing of each of a set of partial rights.

The applicants respectfully note that it is the duty of the Examiner to specifically identify each and every element and limitation of a claim in the cited reference as per 37 CFR 1.104(c)(2) and MPEP 707, which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

The Final Office Action is not in compliance with 37 C.F.R. §1.104(c)(2) and MPEP 707 because the pertinence of Inoue with respect to each of the elements of independent claims 1, 15-16, and 18 is not clearly explained. The goal of prosecution has not been met under MPEP 706 because the Office has not clearly articulated its rejection so that the applicants could have the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

Inoue does not teach decomposing the usage right into a set of partial rights, and subsequently separately signing each one of the set of partial rights. Of particular note, Inoue does not address digital signing at all in Inoue's disclosure.

The Examiner asserts that Inoue teaches separately signing each one of the set of partial rights at paragraph [0006]. The applicants note that a citation at the paragraph level, and particularly to a 25-line paragraph, is not sufficient to specifically identify each and every claimed element in Inoue, as required by 37 CFR 1.104(c)(2) and MPEP 707. Further, the Examiner's assertion is incorrect; at the cited text, Inoue teaches:

"The license management server of the present invention manages usage rules in accordance with which terminals use contents. The terminal devices include a first terminal device used by a first user and a second terminal device used by a second user. This license management server includes: an information storing unit operable to store license information that associates a usage rule with either (a) each of the first terminal device and the second terminal device or (b) each of the first user and the second user; a restriction managing unit operable to obtain restriction information from either the first terminal device or the first user and to store the restriction information, which

shows a restriction on content use by either the second terminal device or the second user; and a ticket issuing unit operable to (1) obtain a usage request from either the first terminal device or the first user, the obtained usage request requesting content use by either the second terminal device or the second user, (2) add, in response to the obtained usage request, the restriction shown in the restriction information in the restriction managing unit to a usage rule associated by the license information with one of the second terminal device, and the second user to produce a new usage rule, (3) produce a first license ticket that permits content use under the new usage rule, and (4) send the first license ticket to either the first terminal device or the first user." (Inoue [0006].)

As is clearly evident, the referenced text does not address digitally signing each of a set of partial usage rights, as asserted in the Office action. The Office action asserts that "a management server that manages usage rights that govern the content use by different terminals or devices, is a functional equivalent of division of rights and authentication of rights by the license management server". The Examiner provides no basis for this determination of "functional equivalence", and, as noted above, the criteria to support a rejection under 35 U.S.C. 102(e) is that the *identical invention* must be shown in as *complete detail* as is contained in the claim. "A functional equivalent" implies that there are some differences between the teachings, else the term "identical to" would be the proper term. Without a specific identification of each of such differences, it cannot be determined whether the "identical invention" is disclosed in the reference in as complete detail as is contained in the claims.

Further, regardless of whether this assertion is correct, this assertion is immaterial to the applicants' claimed signing of each of a set of partial rights, because it does not address a signing of partial rights.

Because Inoue does not teach decomposing a usage right into a set of partial rights, and subsequently separately signing each one of the set of partial rights, as specifically claimed in claims 1 and 16, and because Inoue does not teach a usage right that is a set of individually signed partial rights, as specifically claimed in claims 15 and 18, the applicants respectfully maintain that the rejection of claims 1-2, 4-16, and 18 under 35 U.S.C. 102(e) over Inoue is unfounded, and should be withdrawn.

The Examiner rejects claim 3 under 35 U.S.C. 103(a) over Inoue and Ishibashi (USP 7,353,541). The applicants respectfully traverse this rejection.

Claim 3 is dependent upon claim 1, and in this rejection, the Examiner relies on Inoue for teaching the elements of claim 1. As noted above, Inoue fails to teach the elements of claim 1. Accordingly, the applicants respectfully maintain that the rejection of claim 3 under 35 U.S.C. 103(a) that relies on Inoue for teaching the elements of claim 1 is unfounded for at least the reasons presented above with regard to claim 1, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

/Robert M. McDermott/  
Robert M. McDermott, Esq.  
Reg. 41,508  
804-493-0707  
for: Kevin C. Ecker  
Reg. 43,600

**Please direct all correspondence to:**  
Corporate Counsel – IP&S  
U.S. PHILIPS CORPORATION  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8001  
914-332-0222